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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/932,784	09/18/1997	JAMES A. MCKAIN	A0521/7125	5693

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EXAMINER

NGUYEN, HUY THANH

ART UNIT	PAPER NUMBER
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2621

MAIL DATE	DELIVERY MODE
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01/11/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

08/932,784

Applicant(s)

MCKAIN ET AL.

Examiner

HUY T. NGUYEN

Art Unit

2621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 October 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,9,23 and 45-67 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,9,23 and 45-67 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 29 October 2007 has been entered.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3. Claims 1, 9, 23, 45-56, 58-67 are rejected under 35 U.S.C. 103(a) as being unpatentable over Peters et al (5,946,445) in view of Kojima et al (5,168,363) and Reber et al (5,267,351).

Regarding claims 1, 9, 23, 45-47, 58, 63-67, Peters discloses a digital motion picture recorder comprising:

- a housing sized to be portable for use by an individual (Fig. 1);
- processing means (Fig. 1) in the housing for receiving the motion video signal from a video camera and a processing the received motion video signal;
- a converting means for converting the motion video signal into a sequence of the still image (column 2);
- compressing means (11), Fig. 1)
- storage means (5) for storing the sequence of still images on a computer readable and writable random access medium mounted in the housing (column 3);
- means for specifying a sequence of still images (video clip or different video clips) to be reproduced (column 3, lines 1-41); and
- a motion camera (video camera) for providing the moving picture to the recorder (Fig. 1).

Peter further teaches the individual can specify a portion of the recorded moving picture to be reproduced (specifying a sequence the video clips to be reproduced).

Peters at figure 1 further teaches the recorder can be used with a camera but fails to specifically teach that the motion camera mounted in the housing having the recorder. However, it is noted that combining a camera with recorder for making a portable apparatus is well known in the art as taught by Kojima (Fig. 1, column 1 lines 5-10). Therefore, it would have been obvious to one of ordinary skill in the art to modify the digital recorder of Peters with Kojima by providing a motion camera in the same housing of the digital recorder for portability's purpose therefore providing more advantages to the user in handling the apparatus for capturing the pictures when needed.

Peter as modifying with Kojima fails to teaches that the editing means identifies a segment by using a file and points. However, it is noted that using an editing system for referencing the segments by a file and points is well known in the art (See the specification of the present application, page 9, lines 1-5).

Reber teaches a recording /reproducing apparatus having an editing means associated with reproducing means for reproducing a specified a segment of a digital moving picture from a computer writable medium by referencing to a file and points of the digital video, the editing of Reber capable using with motion camera (column 1, lines 10-20, column 12).

It would have been obvious to one of ordinary skill in the art to modify Peter with Reber by using the editing means as taught by Reber for identifying a segment by a file name and points of the digital still images thereby by accurately accessing the segment for editing or viewing.

Regarding claims 47, 53 and 59, Peter as modified with Kojima further teaches a comprising a display (4) and editing controls on the housing to edit and display the sequence of digital still images (See Kojima (Fig. 7, See Reber Fig. 1).

Regarding claims 48, 54 and 60, Peter as modified with Kojima and Reber further teaches the display and editing controls comprise:

a display for displaying functions available to be selected by a user; and
an input mechanism associated with the displayed indications of functions enabling a user to select the associated function (See Kojima Fig. 7, Reber Fig. 1).

Regarding claims 49, 55 and 61, Peter as modified with Kojima further teaches the computer-readable and writable random-access medium comprises a disk-type drive mounted in a container detachable from the housing (See Peter reference).

Regarding claims 50, 56 and 62. Peter fails to teach using instruction for calibrating cooler . However it s noted that using instruction to calibrating the color is well known in the art as admitted by applicants (See specification page 8). Therefore official Notice is taken and it would have been obvious to one of ordinary to modify Peter as modified with Kojima and Reber by providing the modified apparatus of Peter with a calibrating mean as taught by Uekane for calibrating the color of the still images thereby improving the quality of the viewing still images .

4. Claims 51 and 57 are rejected under 35 U.S.C. 103(a) as being unpatentable over Peter in view of Kojima and Reber as applied to claims 9 and 23 above, and further in view of Uekane et al (5,59,554).

Regarding claims 51 and 57, Peter as modified with Kojima, Reber fails to teach an overlay circuit for receiving an indication of data including at least one of a battery level, time codes, time of day and function performed, and generating video data

indicative of the data; and
an encoder for receiving the sequence of digital still images and the video data to
generate a video signal combining the video data with the sequence of digital still images.

Uekane teaches an recorder having a camera and combining means for receiving an indication data and combining the image of the indication data with the capture video signal (Fig. 12) I would have been obvious to one of ordinary skill in the art to modify Peter with Uekane by providing the apparatus of Peter as modified with Kojima with a combining means as taught by Uekane for combining the image indicating the time or battery level with the still picture image thereby accurately identifying the status of the apparatus.

5. Claims 1, 9, 23, 45-47, 58 and 65-67 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bluth et al (3,617,626) in view of Washino (5,537,157) and Reber et al (5,267,351).

Regarding claims 1, 9, 23, 45, 46, 47, 58 and 65-67, Bluth discloses a digital motion picture recorder (Fig. 1 columns 3-5) comprising:

- a housing sized to be portable for use by an individual (Fig. 1);
- a motion camera (11) for providing motion video signals (column 12, lines 42-72);
- processing means (Fig. 1) in the housing for receiving the motion video signal from a video camera and for processing the received motion video signal;
- a converting means (13) for converting the motion video signal into a sequence of the still images (frames) (column 12, lines 50-60);
- storage means (digital recorder means) for storing the sequence of still images on a readable and writable random access medium mounted in the housing (column 12, lines 54-59)); and
- means for selecting a sequence of the stored sequence still images to be reproduced (column 12, lines 59-65).

Bluth fails to specifically teach that the digital still images (frames) are stored on a computer readable and writable random access medium. However it is noted that processing the motion picture from a camera for processing the motion picture into still frames and storing the digital still images on a digital computer readable and writable random access medium is well known in the art as taught by Washino.

Washino teaches a processing means for processing the motion picture from a camera into a digital still images that can be recorded on digital computer readable and writable random access medium (8) (Figs. 2-3, column 6, lines 25- 45, column 8, lines 28 to column 9, line 37). It would have been obvious to one of ordinary skill in the art to modify Bluth with Washino by using a processing means as taught by Washino for processing the motion picture from the camera into sequence of still mages that can be recorded and read on and from a computer random access medium thereby enhancing the function of the apparatus of Bluth to facilitate accessing and retrieving the stored digital motion picture when needed .

Bluth as modifying with Washino fails to teaches that the editing means identifies a segment by using a file and points

Reber teaches a recording /reproducing apparatus having an editing means associated with reproducing means for reproducing a specified a segment of a digital moving picture from a computer writable medium by referencing to a file and points of the digital video , the editing of Reber capable using with motion camera (column 1, lines 10-20, column 12).

It would have been obvious to one of ordinary skill in the art to modify Bluth r by using the editing means as taught by Reber with the apparatus of Bluth for identifying a segment by a file name and points of the digital still images thereby by accurately accessing the segment for editing or viewing .

6. Claims 1, 9, 23, 45, 46, 47, 58 and 63-67 are rejected under 35 U.S.C. 103(a) as being unpatentable over Washino (5,488,433) in view of Reber et al (5,267,351).

Regarding claims 1, 9, 23, 45-47, 58 and 63-64, Washino discloses a digital motion picture recorder (Fig. 1 columns 3-4) comprising:

- a housing sized to be portable for use by an individual (Fig. 1);
- a motion camera (11) for providing motion video signals (column 3, lines 2-30);
- processing means (Fig. 1) in the housing for receiving the motion video signal from a video camera and for processing the received motion video signal (column 3, lines 3-68, column 4, lines 1-32, 57-68);

- compressing means (column 2, lines 50-68)

- a converting means (13) for converting the motion video signal into a sequence of the still images (frames) (a digital motion or moving picture is a combination of a sequence of still images (frames))

- storage means (digital recorder means) for storing the sequence of still images on a computer readable and writable random access medium mounted in the housing (column 3, lines 55-68, column 4, lines 14-32, 12, lines 54-59)).

Washino fails to teach means for specifying a portion of the stored sequence of still images to be reproduced by referencing to a file and points. However, it is noted that using an editing means with a motion camera is well known in the art and is admitted by applicants (specification page 9, lines 1-5).

Reber teaches a recording/reproducing apparatus having an editing means associated with reproducing means for reproducing a specified segment of a

digital moving picture from a computer writable medium by referencing to a file and points of the digital video, the editing of Reber capable using with motion camera (column 1, lines 10-20, column 12).

It would have been obvious to one of ordinary skill in the art to modify Peter with Reber by using the editing means as taught by Reber for identifying a segment by a file name and points of the digital still images thereby by accurately accessing the segment for editing or viewing.

Response to Arguments

7. Applicant's arguments filed 29 October 2007 have been fully considered but they are not persuasive.

Applicant argues that the applied art do not teaches an editing means that perform editing function on the claims. In response, is noted that the recited ending means or editing in claim is a mere selection of a file and points of the recorded still images or pictures on a medium for reproducing from the medium. That is well known in the art. Further it is noted that a camera combined with a recording/reproducing apparatus to provide a portable device is well known in the art and selecting a sequence of a portion of the digital moving picture from a file and points for reproducing the sequence from a medium is also well known in the art of recording and reproducing data. Since the claims do not specify how the moving picture be recorded or reproduced from a medium is edited, the selection of a

sequence of the digital still images by using a file and points as recited in the claims meet the combination of the applied art.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to HUY T. NGUYEN whose telephone number is (571) 272-7378. The examiner can normally be reached on 8:30AM -6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Miller can be reached on (571) 272-7353. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

HN

HUY NGUYEN
PRIMARY EXAMINER